

Appl. No. 09/678,487  
Reply to Office Action of March 23, 2003

**REMARKS**

This is a full and timely response to the final Office Action mailed March 23, 2004. Reexamination and reconsideration in light of the above amendments and following remarks are courteously requested.

Claims 1-16 are now pending in the application with Claims 1, 3, 9, and 11 being the independent claims. Claims 1, 3, 9 and 11 have been amended. Claims 6 and 13 have been cancelled as redundant in light of the amendments to Claims 3 and 11. Claim 17 had previously been cancelled.

No new matter is believed to have been added.

As a preliminary matter, Examiner's rejections, addressed in turn below, stem from a basic misunderstanding of the invention as claimed. Applicant, therefore, provides the following explanation and clarification of the novel aspects of the invention, with demonstrable support from the specification. Applicant has also amended the claims, as shown in the Listing of the Claims above, and as described in detail below, to further clarify the invention as claimed. Thus, in light of the explanation and reasons given below, Applicant believes that the Application is in condition for allowance.

The invention disclosed herein is useful in a given geographical area, for example, a metropolitan calling area, with multiple area codes (Specification at page 6). For example, the Phoenix metropolitan area has three area codes: 480, 602 and 623. Each area code then has a set number of corresponding or associated three-digit prefixes, e.g., "727" (Specification at pages 6-7, termed the "associated three-digit prefix."). Numerous four-digit suffixes then follow an associated three-digit prefix, resulting in a seven-digit telephone number without the area code, a ten-digit number with the area code, and an eleven-digit number if the metropolitan calling area service requires a one, or other number, to be dialed before the area code (Specification at page 2).

The objective of the disclosed invention is to allow the user to dial the three-digit prefix, then upon entry of the three-digit prefix, a microprocessor begins associating the prefix with the correct area code, or list of possible area codes (Specification at page 3, "Each stored prefix is associated with a particular area code"). Then the microprocessor either begins dialing the entire

Appl. No. 09/678,487  
 Reply to Office Action of March 23, 2003

ten or eleven digit number, while the user enters the remaining four-digit suffix, or returns an area code selection menu.

While the user must enter the four-digit suffix for the call to be completed, the four-digit suffix plays no role in area code determination--and in fact, determination of the area code begins upon entry of the three-digit prefix. (Specification at page 3, "When a telephone number prefix is entered by the user, its associated area code is automatically transmitted before the seven digits representing the prefix and suffix of the telephone number entered by the user are transmitted.") Thus, the net advantage for the user is that the user only enters seven digits instead of the normally required ten or eleven. Further, the microprocessor associates the number with the area code based upon only three digits, instead of seven.

Specifically, according to the present invention, when the user dials the prefix "727" the microprocessor determines whether this three-digit prefix matches a stored three-digit prefix associated with an area code (Specification at pages 6-7, "that the first three digits entered match a three-digit telephone number store in memory 8"). Notably here, the memory 8 (or a database in memory 8) then does not store a seven-digit number, but only three-digit prefixes (requiring less memory and enabling faster association processing). Consequently, once the user enters the three-digit prefix, the microprocessor associates that with an area code, e.g., 480, 602 or 623.

If the prefix "727" is only associated with one area code, e.g., 480 (Specification at page 10, "if fewer than seven digits have been entered, and only one area code is associated with the first three digits"), the microprocessor 6 will effectively and unbeknownst to the user instruct the system to hang up the line, connect again and begin dialing the associated area code or one plus the associated area code, as the particular metropolitan area phone service requires (Specification at page 7, "In certain geographic areas, the digit one must be entered as the first digit of the telephone number"). Then the microprocessor 6 will coordinate the dialing of the three-digit prefix entered prior to initiation of area code association, and then the four-digit suffix entered by the user after association of the three-digit prefix had been initiated by microprocessor 6 (Specification at page 8, "if three or more digits have been entered, processing continues at subroutine B).

If the prefix "727" is associated with more than one area code, e.g., 480 and 602, entry of the three-digit prefix will return a selection menu for the user, through which the user can select the correct area code by entry of one additional digit, e.g., "1" for 480 or "2" for 602

Appl. No. 09/678,487  
Reply to Office Action of March 23, 2003

(Specification at page 7, "In the event the user enters a telephone number prefix that is valid in more than one area code, a display 5 illustrated in Figure 2 is employed to display those area codes, along with an associated selection digit to be entered by the user for selecting a desired one of those area codes"). Once the selection is made, the microprocessor 6 coordinates dialing of the ten or eleven digit number, as illustrated above. It should be noted that although the user may have already entered the four-digit suffix before making the area code selection, the four-digit suffix plays absolutely no role in area code determination. (Id.)

#### Claim Rejections - 35 U.S.C. § 112

The Office Action has rejected Claims 3-8 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. Claim 6 has been cancelled. Specifically, the Office Action states that the specification does not enable the user to dial part of the seven digit number (the three digit prefix), followed by selection of the proper area code, and then completion of the seven digit number (the four digit suffix).

Applicant has amended Claim 3 to clarify the process. Specifically, Applicant has removed the term "being" and has restored the term "previously" to clarify that entry of the area code selection digit occurs after the user enters both the prefix and suffix of the second plurality of digits. This amendment is enabled in the Specification at page 10, paragraph 1 and Fig. 4D.

However, this clarifying amendment does not affect the novelty or patentability of Claim 3, as amended. As discussed below, the novelty of Claim 3 lies in locating, upon entry of the prefix portion, the one or more stored area codes associated with the matching stored prefix portion.

Therefore, in light of the above claim amendment and citation to the specification where the amendment is enabled, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 112 rejection.

Because Claims 4-5 and 7-8 depend from Claim 3, and because independent Claim 3 as amended is enabled by the specification, Claims 4-5 and 7-8 are also enabled for the reasons given with respect to the independent claim.

Appl. No. 09/678,487  
Reply to Office Action of March 23, 2003

Claim Rejections - 35 U.S.C. § 102(e)

The Office Action rejects Claims 9-15 under 35 U.S.C. 102(e) as allegedly being anticipated by Yamartino (U.S. Patent Application No. 09/291,213). Claim 13 has been cancelled. These rejections are respectfully traversed.

Anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. There must be no difference between the claimed invention and the disclosure provided by the reference, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991). Applicant respectfully submits that Yamartino does not teach each and every element of the claims; therefore, the invention, as claimed herein, is not anticipated by Yamartino.

As a preliminary matter, Examiner's final rejection stems primarily from the Examiner's assertion that Applicant stores telephone number area codes along with their associated 7-digit telephone numbers (comprising prefix and suffix) in a database, as in Yamartino. Examiner also asserts that Yamartino teaches or contemplates a database that is limited only to exchange numbers (prefix) and associated area codes, and cites to Column 7, lines 30-47.

First and foremost, Yamartino's statement does not teach the database disclosed by Applicant. Yamartino merely states, in a single passing sentence, that "it may be beneficial to limit the amount of information included in Database 120 to information, such as area codes and exchange codes, that do not change as frequently as, for example, subscriber numbers." See Column 7, lines 33-37 (notably, lines 38-47 do not elaborate on the database whatsoever).

However, this is the extent of disclosure and discussion of such a database in Yamartino. Yamartino does not teach or disclose a database with each possible prefix portion in a predetermined geographic or metropolitan area associated, in the database, with the correct area code or area codes for that prefix. Thus, Yamartino does not teach each and every element of Applicant's Claim 9 and 11, as amended.

Specifically, Yamartino does not teach the limitation of the database to a particular geographic area, but rather teaches that the database includes multiple geographic areas and will preferably include, in the database, reference to each geographic area. Second, Yamartino does not teach or even indicate that the database will comprise a reference to each possible prefix in a geographic area, associated with, each possible area code in which that prefix exists.

Appl. No. 09/678,487  
Reply to Office Action of March 23, 2003

Further, Yamartino actually teaches away from using such a minimal amount of information in the database--and teaches preferred embodiments of the database which, at a minimum, include the entire subscriber number, if not also the geographic area, subscriber name, and so forth. Again, the purpose is to produce lists of entire subscriber numbers. Additionally, Yamartino specifically recites that an advantage of his invention is that the user can then view--and store for later reference--the entire ten-digit number, even if only one ten-digit number is returned. (Column 6, lines 2-19, "Selector 155 will still present the single telephone number to Calling Party 180 so that the Calling Party 180 may note it").

On the other hand, Applicant's invention is advantageously comprised of a minimal amount of associated information. This logically follows, as the database disclosed by Applicant has a completely inapposite purpose from that disclosed in Yamartino. Rather than to return a list of subscriber numbers, Applicant's invention serves to intelligently dial a ten-digit number based upon the area code search results generated from the three-digit prefix entered by the user, followed by the desired four-digit suffix, entered by the user after initiation of the area code search; thus, rendering multiple area codes in a metropolitan area inconsequential to the user.

At no time does Applicant's invention return a display of the ten-digit number. Further, in the event that only one area code is associated with the dialed prefix, the ten-digit number begins dialing with no communication to the user as to the identification of the correct area code. Under Yamartino such a lack of communication to the user for future use would defeat the purpose of his invention.

Furthermore, Yamartino does not disclose or teach a method in which the searching and locating process is initiated immediately upon entry of a three-digit sequence. Even if Examiner's extrapolation of Yamartino were accurate and the database comprised only exchange codes and area codes, according to Yamartino's description, the user must still enter the entire seven-digit number prior to any initiation of the searching process.

This is not the case here. As described above, the sequence is such that the method begins the process of matching the prefix to the area code upon entry of a three-digit prefix (Specification at page 3, line 5-8). In addition, if the user enters a prefix that is valid in more than one area code, a single selection digit may be entered to select the appropriate area code from a list display.

Appl. No. 09/678,487

Reply to Office Action of March 23, 2003

In contrast, as the Examiner correctly states, Yamartino discloses a dialing mechanism in which the search is initiated after the user has entered the seven-digit prefix and suffix. The user, therefore, must dial the entire seven-digit number before any part of the seven-digit number, including the exchange code, can then be used as a search parameter in a database. Thus, again, Yamartino does not teach each and every element of Applicant's Claims 9 and 11, as amended.

Further, Yamartino, in the event of multiple area codes being associated with a prefix, does not teach a selection mechanism that includes only area codes. Simply put, this is because Yamartino does not teach or disclose Applicant's invention, as claimed in amended Claim 11. Yamartino envisions a data return of a display list of "target telephone numbers"--not area codes. Thus, even extrapolating Yamartino to a situation where Yamartino's database contained only area codes and exchange codes, the data return would still consist of a selection of the entire list of target telephone numbers in all possible geographic areas, i.e. all ten digits as required for then dialing the telephone number.

For example, in Yamartino, the user would enter 727-1234, following entry of the entire seven digits, the database would initiate search and return the following: 402-727-1234; 576-727-1234; 480-727-1234; 602-727-1234. In Applicant's invention, on the other hand, when the user entered "727," the microprocessor would immediately begin searching for possible corresponding area codes, only in one geographic region, e.g., Phoenix.

While the microprocessor is in the process of returning the area code selection list, the user will have finished entering the four-digit suffix. The area code selection would then appear as: (1) 480; (2) 602. This is a significantly different result from that disclosed Yamartino. Applicant's simpler visual choice technology renders the instant invention more efficient, and less visually distracting than that of Yamartino. Thus, again, Yamartino does not teach each and every element of Applicant's Claim 11.

In summary, Yamartino does not teach a device, tailored to a particular geographic area, in which the prefix is matched to the area code upon entry of the prefix. Yamartino also does not teach a visual or audio display wherein multiple area codes only are presented, along with a single selection digit. Nor does Yamartino teach a device which includes a database that stores each and every telephone number prefix for a given geographical area associated with their correct area code(s).

Appl. No. 09/678,487  
 Reply to Office Action of March 23, 2003

Because Claims 10, 12 and 14-15 depend from independent Claims 9 and 11, and because independent Claims 9 and 11, as amended, are patentable over the citation of record, Claims 10, 12 and 14-15 are also patentable for the reasons given with respect to the independent claims. Furthermore, as discussed below, because Claims 3-5 and 7-8 claim an apparatus that carries out the method in Claim 11, Claims 3-5 and 7-8 are also patentable for the reasons given with respect to independent Claim 11.

In light of the above amendments and remarks, reconsideration and withdrawal of the § 102(e) rejections are therefore, respectfully requested.

Claim Rejections - 35 U.S.C. § 103(a)

The Office Action rejects Claims 1, 2 and 16 under 35 U.S.C. 103(a) as allegedly being unpatentable over Yamartino in view of Eaton, U.S. 5,710,808. Examiner also makes a bare assertion--without explanation, argument or support--that if even if Claims 3-8 are supported by the specification, they are rejected for the same reasons as Claim 1. These rejections are respectfully traversed.

As a preliminary matter, Claim 3 has been amended to no longer parallel the language in Claim 1. Claim 3, as amended, recites an apparatus that executes the method in Claim 11. Because of the reasons given above for the novelty and thus patentability of Claim 11, Applicant respectfully submits that Claim 3, as amended, is patentable for the reasons given with respect to Claim 11.

Applicant also incorporates by reference its arguments made above with respect to Yamartino and its failure to disclose each and every element of Applicant's invention as claimed. Further, even if, *arguendo*, a suggestion, teaching or motivation did exist in Yamartino to combine it with Eaton, the novel elements of Applicant's invention not found in Yamartino, as identified with respect to Claims 9 and 11, and also claimed in independent Claims 1 and 3, are also not found in the combination of Yamartino and Eaton. Thus, the combination of Yamartino and Eaton do not render independent Claims 1 and 3 obvious.

"In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art." In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.

Appl. No. 09/678,487

Reply to Office Action of March 23, 2003

Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

An adequate showing of motivation to combine requires "evidence that 'a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention', would select the elements from the cited prior art references for combination in the manner claimed." Ecolchem, Inc. v. Southern Calif. Edison Co., 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000) (quoting In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Here, Examiner is clearly "combining prior art references without evidence of such a suggestion, teaching, or motivation" and has simply taken the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. This exercise by the Examiner is undoubtedly a result of hindsight, and is not sufficient or permissible to defeat patentability. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Examiner states that Eaton's device is implemented for the purpose of "providing enhanced services to the user such as adding to, altering or blocking a portion of the received digits to facilitate billing or user identification." However, Yamartino has absolutely nothing to do with facilitating billing or user identification. Further, Applicant's invention also has no suggestion of being used to facilitate billing or user identification. Thus, on this fact alone, the lack of evidence as to any suggestion or motivation to combine Yamartino and Eaton is clear.

Further, when the device in Eaton adds numbers to a given dialed number, the addition functions so as to have the "effect of re-routing the trunk call being made through their system rather than through a competitor's system" (Column 4, lines 20-37) or as alternately described "to make the connection along an alternate route." Again, as Examiner correctly asserts--to facilitate billing or user identification.

Such addition of numbers on the "backside" of the user entry has no relationship whatsoever to the user assistance mechanisms provided for in Yamartino or in Applicant's



Appl. No. 09/678,487

Reply to Office Action of March 23, 2003

invention. As discussed above, the purpose of Yamartino is to provide a user with a list of complete ten-digit phone numbers, then upon receiving the list, the user selects the desired ten-digit number, and the call is placed dialing all ten-digit numbers. Further, because Yamartino requires that all seven digits are entered before any choices are even viewable, there is absolutely no motivation to implement a method in combination with Yamartino that would begin dialing an undetermined ten-digit number prior to complete entry of the seven-digit number.

Rather, Examiner has used Applicant's disclosure as a blueprint, in that Examiner has merely collected two prior art references which do not provide any internal suggestions, teachings or motivation and has attempted to combine them. Examiner's analysis is rather the result of hindsight, and does not make a sufficient prima facie case to defeat patentability. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In light of the above amendments and remarks, reconsideration and withdrawal of the § 103(a) rejections are therefore, respectfully requested.

The other art of record is also not understood to disclose or suggest the inventive concept of the present invention as defined by the claims.

#### Conclusion

Applicant submits that the present application is in condition for allowance. Favorable reconsideration and withdrawal of the rejections set forth in the above-noted Office Action, and a Notice of Allowance are requested.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

Respectfully submitted,

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